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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,272	12/02/2003	Leon R. Manole	2003-056	1271

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EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,272

Applicant(s)

MANOLE ET AL.

Examiner

Bret C Hayes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 2,4,6,8,20,22,24 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

2. Claims 2, 4, 6, 8, 20, 22, 24 and 26 are objected to because of the following informalities: claim 2, line 3, (2:3), "an observer" should be --the observer--; 4:2, remove "a" before "separate"; 6:2, remove "the" before "launch"; 8:3, "of the target" should be --with the target--; 20:3, "an observer" should be --the observer--; 22:2, remove "a" before "separate"; 24:2, remove "the" before "launch"; and 26:3, "of the target" should be --with the target--. Appropriate correction is suggested.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 – 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Claims 1 – 39 make reference to a first and second “heat chemical”, which is not enabled by the disclosure. The disclosure states, “[h]eat chemicals 115 compris[e], for example, calcium chloride and thickener hydroxyethyl cellulose or cellulose acetate butyrate,” and that “[i]n an alternate embodiment powdered metals or sodium acetate or other salts may be used with or in place of calcium chloride in 115,” and further, “Liquid 125 comprising, for example, hydrogen peroxide and/or a mixture of water and/or salt water and/or propylene glycol are contained in bag 130.” The disclosure further states, “A gel 305 is placed in one or more sealed glass vials 310. Gel 305 comprises, for example, water, propylene glycol (**optional**), salt NaCl (**optional**) and hydroxyethyl cellulose (**optional**)”, and, further, that, “[the] glass vials 310 are surrounded by heat chemicals 315 comprising, for example, calcium chloride, and/or sodium acetate, or other salts.” (*Examiner’s emphasis added.*) The phrases “for example”, “or”, “may be used with or in place of” and “and/or” are hardly definitions of “such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” By the written description, assuming one eats a gelatin dessert and promptly brushes one’s teeth, one produces the claimed ‘heat chemicals’. Since anyone using a baking soda toothpaste, (baking soda = sodium bicarbonate, NaHCO_3 , an “other salt”, and, toothpaste, which commonly uses ‘hydroxyethyl cellulose’ as a stabilizer) and running it under tap water, (inherently a ‘mixture of water’, since tap water is less than pure H_2O) in order to wash the gelatin, (a gel), off the teeth, generates the claimed ‘heat chemicals’.

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6. Any claim not referencing 'heat chemicals' is rejected as being dependent upon a rejected base claim.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1 – 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1, 19 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: thermal and/or night vision devices, as "heat visible by an observer" is not normally possible as claimed.

10. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: non-heat conducting materials. The reason for this rejection is partly because claim 38 depends upon a claim specifically reciting a heat conducting material, while claim 37 does not so depend, and, partly because a distinction should be made between heat and electrical conductance. The issue is whether one skill in the art would recognize 'non-conducting' as 'non-heat conducting'. For clarity, examiner suggests at least amending to recite --non-heat conducting--.

11. Claim 8 recites the limitation "containment bags" in line 4. There is insufficient antecedent basis for this limitation in the claim as claim 5 recites only "a containment bag".

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12. Claims 13 and 14 recite the limitation "the first and second chemlucent chemicals" in lines 1 and 2, and 4 and 5, respectively. There is insufficient antecedent basis for this limitation in the claims.

13. Claim 18 recites the limitation "the optional chemlucent chemicals" in line 3. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 33 recites the limitation "the spider" in line 2. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 36 recites the limitation "the optional chemlucent chemicals" in line 3. There is insufficient antecedent basis for this limitation in the claim.

16. Any unspecified claim is rejected as being dependent upon a rejected base claim.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1 – 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 10 of U.S. Patent No. 6,497,181 B1 to Manole et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims cover the combination of structural elements and further

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combining chemiluminescent reagents to provide infrared light, see claim 5, specifically, which is also known as the radiation given off by the warmth of an object or the object's heat.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (703) 306 – 4198. The fax number is (703) 872 – 9306.

bh

7/30/04


MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER